REMARKS/ARGUMENTS

Applicants thank the Examiner for his careful review of this application. Claims 53-60 have been rejected. Applicants respectfully request reconsideration of the application in view of the following remarks submitted in support thereof.

Notice of Appeal

A Notice of Appeal is being filed along with this response, as the Applicants believe that the claims are in condition for appeal.

Obviousness Rejections under 35 U.S.C. §103(a)

Claims 53-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,949,431 to Matsumura et al. in view of U.S. Patent No. 5,982,381 to Joshi et al. As will be fully explained below, the combination of Matsumura et al. in view of Joshi et al. does not raise a *prima facie* case of obviousness against independent claims 53 and 58.

Independent claims 53 and 58 define a method and a system for positioning an adjustable image relative to a cutout region within a foreground image. In the method and system defined in independent claims 53 and 58, a scaling parameter is determined such that upon translating and scaling the adjustable image accordingly, a significant portion of a zone of interest appears within the cutout region without changing an aspect ratio of the adjustable image.

In response to the Applicants' arguments dated December 8, 2003, the Examiner noted that Joshi et al. teach a method and a system that scale an adjustable image accordingly such that a significant portion of the zone of interest appears within the cutout region, as defined in independent claims 53 and 58. Applicants again respectfully traverse the Examiner's characterization of Joshi et al. relative to independent claims 53 and 58 because

portions of the reference relied upon by the Examiner (col. 6, lines 49-59 and col. 8, lines 8-15) do not teach or suggest scaling the adjustable image accordingly such that a significant portion of the zone of interest appears within the cutout region without changing the aspect ratio of the adjustable image. In particular, the Examiner noted that Joshi et al. teach modifying a sprite by using "scaling values" (col. 6, line 53). The Examiner therefore reasoned that the term "scaling values" teaches scaling the adjustable image. However, column 6, lines 5-8 of Joshi et al. disclose:

> After the scaling mask 68 is prepared, the colors of the pixels in the original sprite 50 are modified according to their respective scaling values in the scaling mask, and the modified colors are stored in the modified sprite 70.

Thus, according to the above paragraph, Joshi et al. actually teach the use of the scaling values to modify colors of pixels. As Joshi et al. merely disclose scaling colors of pixels, Joshi et al. cannot be reasonably be considered to teach or suggest scaling the adjustable image, as defined in independent claims 53 and 58.

Furthermore, in support of the Examiner's characterization that Joshi et al. teach scaling the adjustable image accordingly whereby a significant portion of a zone of interest appears within the cutout region without changing an aspect ratio of the adjustable image, the Examiner additionally noted that Joshi et al. teach "the sprite which contains the cutout image is presumably set to be sufficiently large to provide at least the selected width w around the cutout feature for compositing with the background image of the same resolution (without changing the aspect ratio of the adjustable image) within the cutout region" (see Final Office Action mailed February 24, 2004 at page 4). Applicants again respectfully traverse the Examiner's characterization of Joshi et al. Specifically, the sprite of Joshi et al. actually describes a region surrounding the cutout feature. The size of the sprite cannot dictate the size of the cutout feature as "the size of the sprite 50 depends on the size of the cutout feature

40" (col. 4, lines 2-4). In effect, the sprite actually describes how the cutout feature is stored in memory as a smaller sprite "reduces the amount of memory required to store a cutout feature" (col. 4, lines 9-10). As a result, the sprite is limited by the size of the cutout feature, but Joshi et al. do not disclose anywhere that the cutout feature may be scaled.

Further, the Examiner notes that Joshi et al. teach the aspect ratio of the adjustable image not being changed. The Applicants respectfully traverse the Examiner's characterization of Joshi et al. First, Joshi et al. do not disclose anywhere in the specification the term "aspect ratio." Moreover, as discussed above, the size of the sprite is limited by the size of the cutout feature. The "cutout feature typically has an irregular shape" and "the size of the sprite may be set to a minimum such that the straight edges of the sprite touch the edge of the cutout feature" (col. 3, line 61 and col. 4, lines 7-9). If the sprite may be reduced such that its edges touch the cutout feature with an irregular shape, then the aspect ratio of the sprite must be changed to conform to the irregular shape of the cutout feature. Therefore, Joshi et al. do not teach or suggest that the sprite must maintain its aspect ratio when the sprite is reduced. Accordingly, Joshi et al. cannot reasonably be considered to teach or suggest to one having ordinary skill in the art scaling the adjustable image accordingly whereby a significant portion of a zone of interest appears within the cutout region without changing an aspect ratio of the adjustable image, as defined in independent claims 53 and 58.

To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations (see M.P.E.P. § 2143). Here, in view of the incorrect characterization of Joshi et al., the references as combined do not teach all the features of the claimed invention.

Additionally, to establish a prima facie case of obviousness based on a combination of references, there must be some suggestion or motivation, either in the references or in the

knowledge generally available to one having ordinary skill in the art, to combine the references in the manner proposed. As will be explained below, the Examiner has not established a *prima facie* case of obviousness against the claimed subject matter because one having ordinary skill in the art would not have combined Matsumura et al. and Joshi et al. in the manner proposed by the Examiner.

In response to the Applicants' arguments, the Examiner noted that incorporating Joshi et al. into Matsumura et al. would have been obvious to one of ordinary skill in the art because "a scaling mask for the sprite is created from the distance mask as an intermediate step that contains a scaling value for each corresponding pixel in the sprite to generate the new scaling values to result in different modified images" (see Final Office Action mailed February 24, 2004 at pages 4-5). As discussed previously, Joshi et al. teach the use of the scaling values to modify colors of pixels - not image sizes. The invention disclosed in Matsumura et al. has nothing to do with modifying colors of pixels. In fact, Matsumura et al. only mention color three times throughout the entire specification, and the colors are discussed in the context of "color CRT" (i.e., color cathode-ray tube) (col. 3, line 53; col. 5, line 50; and col. 7, line 31). Further, the teachings of Joshi et al. focus on speeding up edge softening calculations while, in contrast, the teachings of Matsumura et al. relate to "allocating different layout priorities to the plurality of masked imaged parts" (col. 2, lines 46-47). Edge softening calculations and allocating different layout priorities relate to entirely different technologies and applications. As the teachings of Joshi et al. have nothing to do with the problems addressed by Matsumura et al., Applicants submit that there would not have been any motivation for one having ordinary skill in the art to combine Joshi et al. and Matsumura et al. in the manner proposed by the Examiner.

Finally, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see M.P.E.P. § 2143.01). As discussed previously in Applicants' Amendment dated December 8, 2004, Joshi et al. disclose a modified sprite "composited with the background image to form a composite image" (col. 4, lines 39-41). As illustrated in Figure 2, the sprite can only be situated on top of the background image to form a composite image. On the other hand, as discussed above, Matsumura et al. focus on allocating different layout priorities and as a result, a user may change the layout relationship between the image parts. If Matsumura et al. is modified in accordance to the teachings of Joshi et al., the user would not be able to allocate different layout priorities to different image parts because Joshi et al. only teach forming a composite image by situating an image on top of another image. Thus, the proposed modification of forming a composite image by situating an image on top of another image renders Matsumura et al. inoperable for its intended purpose of allocating different layout priorities for each image. Since the modification would render Matsumura et al. unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification or combination.

Accordingly, for the above-stated reasons, Applicants submit that independent claims 53 and 58 are patentable under 35 U.S.C. §103(a) over Matsumura et al. in view of Joshi et al. Claims 54-57 and 59-60, each of which depends directly or indirectly from independent claims 53 and 58, are likewise patentable under 35 U.S.C §103(a) over Matsumura et al. in view of Joshi et al. for at least the same reasons set forth for independent claims 53 and 58. As a result, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. §103(a) rejection for claims 53-60.

Conclusion

In view of the foregoing, the Applicants respectfully submit that all the pending claims 53-60 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present request, the Examiner is requested to contact the undersigned at (408) 749-6900 ext. 6924. If any additional fees are due in connection with filing this request, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ROXIP228C). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
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